

### REMARKS

The present amendment is submitted in response to the Office Action entered on August 29, 2006. A petition for a three month extension of time is submitted herewith. Claims 1-24 were originally pending. Of these, claims 1, 10, 19 and 22 were withdrawn from consideration. Applicant notes with appreciation that the Examiner agreed with Applicant's traversal of the previously imposed restriction requirement.

The Examiner objected to Figure 1 of the drawings for lacking a "prior art" identifier. The Examiner further rejected claims 11-18 under 35 U.S.C. §101 as addressed to non-statutory subject matter. Claims 2, 3, 5, 6, 11, 12, 14, 15, 20 and 23 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pub. No. 2001/0040867 issued to Onodera et al. (Onodera). Claims 4, 7, 8, 13, 16 and 17 were rejected as obvious under 35 U.S.C. §103(a) in view of Onodera in combination with Japanese Pub. No. 2003/051118 issued to Tsunemitsu et al. (Tsunemitsu). Claims 9, 18, 21 and 24 were rejected as obvious under 35 U.S.C. 103 (a) in view of Onodera in combination with Japanese Pub. No. 2002/367173 issued to Kazutaka (Kazutaka).

Claims 2, 3, and 11-18 are hereby amended. New claims 25-52 are added. Reexamination and reconsideration in view of the amendments and arguments submitted herein is respectfully requested.

**The Examiner objected to Figure 1 of the drawings for lacking a "prior art" identifier.** Applicant respectfully disagrees. Figure 1 shows an optical disk recording apparatus according to an embodiment of the present invention and is described in that way in the specification (see, e.g. ¶ 69).

**The Examiner rejected claims 11-18 under 35 U.S.C. S101 as being addressed to non-statutory subject matter.** Claims 11-18 are hereby amended to recite a "machine readable medium comprising a program" instead of "a program." Applicants respectfully submit that as amended the claims recite patentable subject matter under §101.

**Claims 2, 3, 5, 6, 11, 12, 14, 15, 20 and 23 were rejected under 35 U.S.C. §102(b) as being anticipated by Onodera.** Of these, claims 2, 11, 20 and 23 are independent. These independent claims were amended to specify that both the image and the image formation information are placed in a “program area” of the optical disk. Accordingly, claim 2 recites “forming the visual image in the program area of the optical disk” and “recording the image formation information in the program area.” Claims 11, 20 and 23 include similar recitations.

Onodera discloses copying information found in the table of contents (TOC) of an audio CD and “drawing” that information as an image on the audio CD (see ¶¶ 63, 64). The TOC area is not the area of an audio CD used to store information in general (e.g., music). Instead, it is a specific area used to store metadata, or description of the music stored in the program area, such as name of album, author, names of tracks, etc. Therefore, Onodera does not disclose storing image formation information in a program area of the optical disk.

Storing image formation information in the program area has specific advantages over the TOC area. The TOC area is very limited in size and is mostly used to store plain text. Therefore, the only images that can be possibly “stored” in the TOC are plain text images. Thus, Onodera is limited to placing plain text images on the surface of a CD. In contrast, the present invention according to independent claims 2, 11, 20 and 23 can be used to place much more complex images on an optical disk, because they allow the image formation information to be much larger and thus describe much more complex images.

Thus, independent claims 2, 11, 20 and 23 are patentable in view of Onodera for the reasons discussed above. Claims 3, 5, 6, 12, 14, and 15 are patentable because they depend upon patentable claims 2 and 11.

**Claims 4, 7, 8, 13, 16 and 17 were rejected as obvious under 35 U.S.C. §103(a) in view of Onodera in combination with Tsunemitsu.** Applicant respectfully submits that Tsunemitsu cannot be used to reject claims 4, 7, 8, 13, 16 and 17 as it does not qualify as prior art.

Tsunemitsu was published after the priority date of the present application. A certified English translation of the priority document of the present application is enclosed herein.

**Claims 9, 18, 21 and 24 are rejected as obvious under 35 U.S.C. 103 (a) in view of Onodera in combination with Kazutaka.** Applicant respectfully submits that Kazutaka cannot be used to reject claims 9, 18, 21 and 24 either as it also does not qualify as prior art. Kazutaka was also published after the priority date of the present application.

**New claims 25-52 are added.** Claims 25-30 are patentable in view of the cited art, because they depend from patentable claims 2 and 11.

Of claims 31-52 claims 31, 40, 49 and 51 are independent. Claims 31, 40, 49 and 51 are allowable, because they each recite that the image formation information is stored in the optical disk *after* the image is placed on the disk. This may provide practical benefits. Storing the image formation information after the image is placed on the disk means that the image need not be limited by the image formation information and that the image formation information may be generated based on the image. Thus, a wide variety of images may be used.

Onodera does not disclose this. On the contrary, Onodera states that the TOC is written on the disk before the image. See flow chart spanning Figs 5 and 6. The TOC is written in the beginning of the flow chart (Fig. 5) while the image is drawn on the disk towards the end of the flow chart (Fig. 6).

For the above discussed reasons, claims 31, 40, 49 and 51 are patentable in view of Onodera. Claims 32-39, 41-48, 50 and 52 are patentable because they depend from patentable claims 31, 40, 49 and 51.

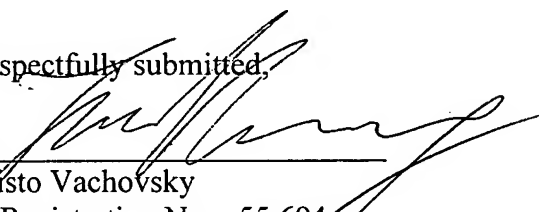
Accordingly, for the reasons discussed above, the present claims are believed to be in condition for allowance.

If, for any reason, the Examiner finds the application other than in condition for allowance, Applicants request that the Examiner contact the undersigned attorney at the Los Angeles telephone number (213) 892-5790 to discuss any steps necessary to place the application in condition for allowance.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. 393032038600.

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Respectfully submitted,

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